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## REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.104, and in light of the following remarks, are respectfully requested.

Amendments

Independent claims 17 and 22 have been amended in light of the newly cited Patterson patent to recite a "plastic" tape, support for which is provided at page 1 (line 11) and various other places throughout the specification. Claim 22 is further amended, consistent with claim 17, that the tape can be releasably adhered to itself. No new matter is presented.

Rejection under 35 U.S.C. 112

The examiner bases this rejection on a supposed lack of any disclosure from which an artisan of ordinary skill in this art could be reasonably assured that applicant had invented a tape without perforations. The rejection is buttressed by arguments that "to the examiner, the recitation of 'unscored' is a new concept." To the contrary, a tape is either scored or unscored, and all of applicant's drawings and written description is directed to unscored tapes. To say that the inventor had possession of tape but not an unscored tape is illogical, and thus is not how one of ordinary skill in the art would read applicant's specification. Not only are examples not required, but recitation of known structure, structure that would be familiar (here, the most familiar) to one of ordinary skill in the art, does not raise an issue of compliance with the written description requirement. *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 79 U.S.P.Q.2d (Fed. Cir., 2006), *cert den.*, 127 S.Ct. 1151 (2007). The rejection fails to explain how the "concept" of an unscored tape, other than *verbatim* disclosure, would not be appreciated by one of ordinary skill in the art as being in possession of the applicant. Accordingly, this rejection should be withdrawn.

Declaratory Evidence under 37 C.F.R. §1.132

The examiner's dismissal of the declarations as "contrived" is contrary to law to the extent that such declarations attest to *facts*, which are "highly probative". *In re Payne*, 606 F.2d 303, 203 U.S.P.Q. 245 (C.C.P.A. 1979). Whether a device provides benefits to others may be an opinion, but whether it provides a direct benefit to one's business is a *fact* that the examiner cannot dismiss.

The declarations need not show that others were working on this problem, especially as it is well known in patent law that appreciation of the problem is a basis for patentability. *E.g., In re Smith*, 458 F.2d 1389, 173 U.S.P.Q. 679 (C.C.P.A. 1972); MPEP 716.04 (III). Whether others could solve the problem is irrelevant to patentability.

#### Rejections under 35 U.S.C. §103

The present independent claims have been amended to distinguish the newly cited reference Patterson (US 497,336). The "insulating-tape" of that disclosure is fundamentally different from the claimed invention and explicitly teaches away from the present claims. Peterson notes that prior tapes "hav[e] been of uniform consistency and wound on of uniform thickness no air spaces have been left between the wires." (Page 1, col. 1, ln. 14-17.) As Peterson's description and Fig. 5 show, for telegraph lines the intent was to physically separate the wires from each other, hence the scoring of the *paper* tape that when wound forms a ridge *b* allowing air spaces between individually wrapped wires. The Peterson tape is intended to cover the *entire length* of a telegraph wire (see page 1, col. 1, ln. 36-40).

None of Figliuzzi, Thomason, or Hugley (*et al.*) shows any appreciation for unwinding a tape after it is in place. Thomason, being directed to tissue, and to the "beginning or end of the roll" and not to any random intermediate section, is not at all related to the claimed plastic adhesive tape.

The rejection has not shown any functional relationship between any marking on the tape and unwinding the tape *after* it has been used. Applicant has been arguing the unappreciated utility of a tape with such a structure, and the § 1.132 declarations were submitted as evidence of that unappreciated benefit. Accordingly, claims 17 and 22 have been amended to additionally explicitly recite that structure in tape that has been wound onto an object. As the examiner has alleged that *unwinding* the tape is not commensurate with the claim scope (presumably unwinding after the tape has been unwound from the supply roll and then wound onto an object), the scope of the claims is now commensurate with the showing made, and distinguishable from the art cited.

The examiner's opinion that the number and/or colors of lines "merely express design content" is hindsight reconstruction in the context of unwrapping the tape. None of the prior art even mentions unwrapping tape. Figliuzzi and Thomason are thus not concerned with the same problem as applicant. The examiner's contention that the choice of "a color involves only routine skill" does not support the rejection for a

structure having two lines of different colors (or two lines of the same color, one line of alternating colors, or any conceivable permutation of lines and color that might be imagined).

In light of the foregoing, withdrawal of this rejection is now believed to be warranted.